



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/671,119

09/24/2003

Matthew B. Prince

006470.P001

7247

8791

7590

04/30/2008

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER

ABEDIN, SHANTO

ART UNIT

PAPER NUMBER

2136

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,119	Applicant(s) PRINCE, MATTHEW B.	
	Examiner SHANTO M Z ABEDIN	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-36 and 67-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-36 and 67-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the communication filed on 04/01/2008.
2. Finality of the previous office action is withdrawn, and subsequently, this office action is made FINAL.
3. Claims 29-36 and 67-82 are pending in the application.
4. Claims 29-36 and 67-82 have been rejected.

Response to Arguments

5. Applicant's arguments with respect to claims 29-36 and 67-82 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-36 and 67-79 are rejected under 35 USC 103 (a) as being unpatentable over Ben Livingston (Possible modifications to Washington, anti-spam law, Internet Newsgroup, January 31, 2002) in view of Morkel (US 7007068 B2)

Regarding claim 29, Ben Livingston discloses computer implemented method comprising:

collecting a set of one or more do-not-email list entries, each do-not-email list entry is a string of characters representing an email address (Paragraph 4; do not email list);

transferring the set of one or more do-not-email list entries to a master do-not-email list server configured to store the set of one or more do-not-email list entries (Paragraph 3 and 4; registrant having do not email list) ;

comparing the client email entry to the do-not-email list entries on the client do-not-email list to determine whether the client email entry appears on the client do-not-email list (Paragraph 3 and 4); and transmitting at least one email to the email address that corresponds to the client email entry upon determining that the client email entry does not appear on the client do-not-email list (Paragraph 3 and 4; contacting registrant for every email address in their list).

Although Ben Livingston does teach storing and comparing the recipients email addresses in an ant spam/ registry such as do not email list, it fails to disclose expressly use of hashed email addresses in that purpose. In particular, Ben Livingston fails to disclose: applying a one-way hashing scheme to the set of one or more email list entries to convert the strings of characters into unique hashed values to create a set of one or more hashed email list entries, wherein the one-way hashing scheme is intended to conceal the email list entries from an intended recipient; one or more hashed email list entries without revealing the email address corresponding to each of the hashed email list entries; requesting from the

master list server at least one hashed email list entry from the set of one or more hashed email list entries to create or update a client email list on a client machine; causing a client email entry to be hashed using the same one-way hashing scheme to create a hashed client email entry; and comparing the hashed client email entry to the client email list.

However, Morkel discloses

applying a one-way hashing scheme to the set of one or more email list entries to convert the strings of characters into unique hashed values to create a set of one or more hashed email list entries, wherein the one-way hashing scheme is intended to conceal the email list entries from an intended recipient (Col 2, starts at line 20; claims 15, 16; hash of email address; mapping id to email address to conceal email address);

one or more hashed email list entries without revealing the email address
corresponding to each of the hashed email list entries (Col 2, starts at line 20; claims 15, 16);

requesting from the master email list server at least one hashed email list entry from the set of one or more hashed email list entries to create or update a client email list on a client machine (Col 2, starts at line 30);

causing a client email entry to be hashed using the same one-way hashing scheme to create a hashed client email entry (Col 2, starts at line 15); and

comparing the hashed client email entry to the client email list (Col 2, starts at line 15).

Therefore, Morkel's teachings of hashed email entries can be used in Ben Livingston's anti spam/ registrant's do not email list to create a list of hashed email

addresses that can be used to conceal the real do not email list for privacy and security reasons.

Morkel and Ben Livingston are analogous art because they are from the same field of endeavor of secure email communication . At the time of the invention it would have been obvious to a person of ordinary skill in art to combine the teaching of Morkel with Ben Livingston to design a method further include the steps involving hash of email addresses in order to provide a suitable method for concealing the email addresses.

Regarding claim 30, it is rejected applying as above rejecting claim 29, furthermore, Ben Livingston discloses a maser do not email list (Par 3-5; do not email list; mailing list in domain registrant). Ben Livingston fails to disclose hash of email of addresses.

However, Morkel discloses the method wherein the hashed client email entry is a hashed value of an email address stored on the client machine, the client machine performs the causing of the client email entry to be hashed, the client machine performs the requesting from the email list server, and the client machine performs the comparing the hashed client email entry to the client email list (Col 2, starts at line 20; claims 15, 16; hash of email address; mapping id to email address to conceal email address).

Regarding claim 31, it is rejected applying as above rejecting claim 30, furthermore, Morkel discloses the method wherein the hashed client email entry is a hashed value of an email address stored on the client machine and the client machine performs the causing of the client email entry to be hashed (Col 2, starts at line 20; claims 15, 16).

Regarding claim 32, it is rejected applying as above rejecting claim 31, furthermore, Ben Livingston discloses a master do not email list (Par 3-5; do not email list; mailing list in domain registrant). Ben Livingston fails to disclose hashed email list entries.

However, Morkel discloses configuring a master email list database to be in communication with the master email list server, the master email list database configured to store the set of one or more hashed email list entries for the email list server (Col 2, starts at line 20; claims 15, 16).

Regarding claims 33-35, they recite the limitations of claims 29-32, therefore, they are rejected applying as above rejecting claims 29-32.

Regarding claim 36, Ben Livingston discloses the method as in claim 35 wherein the email marketer uses the client do-not-email list application to periodically check bulk email lists maintaining by the email marketer to have email addresses associated with the set of one

or more do-not-email list entries be kept free of spam (Par 3-5; do not email list; spammer must contact registrant).

Regarding claim 67 and 71, they are rejected applying as same rationale and motivation applied as above rejecting claim 29, furthermore, Ben Livingston discloses a computer implemented method to identify email addresses registered on a do not contact list that are in a client's list without revealing the email addresses on the contact list or the client's list comprising:

a maser do not email list (Par 3-5; do not email; mailing list in domain registrant); and
the client transmitting over a network said plurality of entries from the client's list to a service for comparison to entries of the contact list, wherein the entries of the contact list were formed by including at least an email address, a matching of an entry from said plurality of entries from the client's list to an entry of the contact list (Par 3 and 4); and the client receiving results of the comparison (Par 3 and 4).

Ben Livingston fails to disclose
encrypted entries of the contact list; and
the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address; the client transmitting over a network said plurality of encrypted entries from the client's list to a service for

comparison to encrypted entries of the contact list, wherein the encrypted entries of the contact list were formed by encrypting information, Including at least an email address, a matching of an encrypted entry from said plurality of encrypted entries from the client's list to an entry of the contact list represents that the underlying email address needs to be identified.

However, Morkel discloses

encrypted entries of the contact list (Col 2, starts at line 45); and

the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address (Col 2, starts at line 47; contact information; matching hash; Col 4, starts at line 60; encrypted id/email address/data);

the client transmitting over a network said plurality of encrypted entries from the client's list to a service for comparison to encrypted entries of the contact list, wherein the encrypted entries of the contact list were formed by encrypting information, Including at least an email address, a matching of an encrypted entry from said plurality of encrypted entries from the client's list to an entry of the contact list represents that the underlying email address needs to be identified (Col 2, starts at line 47; Col 4, starts at line 60; matching; encrypted id/email address/data).

Regarding claims 68-70, 72-78, they recite the limitations of claims 29-36 and 67, therefore, they are rejected applying as above rejecting claims 29-36 and 67.

Regarding Claim 79, it recites the limitations of claims 29 and 67, therefore, it is

7. Claims 80 - 82 are rejected under 35 USC 103 (a) as being unpatentable over Ben Livingston (Possible modifications to Washington, anti-spam law, Internet Newsgroup, January 31, 2002) in view of Morkel (US 7007068 B2) further in view of Lu (US 7174453 B2).

Regarding claim 80, it is rejected applying as above rejecting claim 79, furthermore, Ben Livingston teaches matching one of the entries of the master do-not-contact list (Par 3 and 4).

Ben Livingston fails to disclose when the encrypted entry that matches one of the encrypted entries of the master list of belongs to the minor is automatically removed from the client' s list.

However, Lu teaches when the encrypted entry that matches one of the encrypted entries of the contact list of belongs to the minor is automatically removed from the client's list (Col 3, starts at line 5; Col 4, starts at line 12; claims 12, 36; block/delete intended recipient/child senders; forwarding/directing to supervisory/parent or guardian recipient).

Lu and Ben Livingston are analogous art because they are from the same field of endeavor of anti spamming. At the time of the invention it would have been obvious to a person of ordinary skill in art to combine the teaching of Lu with modified Ben Livingston - Morkel method to include when the encrypted entry that matches one of the encrypted entries of the contact list of belongs to the minor is automatically removed from the client's list in order to provide internet security for the minors.

Regarding claim 81, it is rejected applying as above rejecting claim 80, furthermore, Lu discloses associating the email address that belongs to the minor with a parent's address (Col 3, starts at line 5; claims 12, 36).

Regarding claim 82, it is rejected applying as above rejecting claim 80, furthermore, Morkel discloses the encrypted entry that belongs to the client's list (Col 4, starts at line 60).

Modified Ben Livingston - Morkel method ails to disclose causing a notification to be sent to the parent's address to notify the parent when there is a request to remove the contact information associating with the entry that belongs to the minor from the client's list.

However, Lu discloses causing a notification to be sent to the parent's address to notify the parent when there is a request to remove the contact information associating with the entry that belongs to the minor from the client's list (Col 3, starts at line 5; claims 1,12-13, 3 6; notification to supervisory/parent; intended/child).

Conclusion

8. Applicant's amendment (filed on 11/23/2007) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

Art Unit: 2136

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, A.U. 2136

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2136